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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,025	12/26/2001	Achim Grefenstein	217712US0PCT	5931

22850 7590 01/21/2004

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EXAMINER

BISSETT, MELANIE D

ART UNIT PAPER NUMBER

1711

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,025	Applicant(s) GREFENSTEIN ET AL.	
	Examiner Melanie D. Bissett	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
 4a) Of the above claim(s) 21-24 and 28-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 0302 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0302</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of Group I in the paper filed 8/28/03 is acknowledged. The traversal is on the ground(s) that the International Preliminary Examination Report did not hold a lack of unity in the parent PCT case. This is not found persuasive because the US application is separate from the International application and thus does not require complete conformity with the International application. In response to the applicant's arguments that the examiner's conclusory statements do not adequately support patentable distinctness, note that each of the special technical features have been pointed out and differentiated from one another. Also, prior art has been cited to show that the technical feature relied upon by the applicants in claim 18 is obvious and thus does not provide a common "*special*" technical feature. Regarding the applicant's arguments that a search of all the claims would not impose a serious burden on the Office, it is noted that the Office is not required to show an imposition of search burden under the requirements of lack of unity. The requirements for lack of unity can be found in the MPEP, Chapter 1800.
2. The requirement is still deemed proper and is therefore made FINAL.
3. Also, note that the applicant has incorrectly included claims 21-28 in the election statement on p. 1 of the response filed 8/28/03. It is the examiner's position that this is a typographical error, since the groups have been correctly cited on p. 2 of the same paper. For clarification purposes, it is noted that elected Group I contains claims 18-20 and 25-27.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 18-20 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 18 recites the limitation "back-molding material" in line 3. There is insufficient antecedent basis for this limitation in the claim. Because of the mention of two materials used in the back-molding process, it is unclear to which material the "back-molding material" refers. Since the polymer film is specified as a "back-molding film", it is the examiner's position to treat the "back-molding material" as referring to the material of the back-molding film.

7. Claim 26 recites the limitation "the transparent top layer" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

8. Claims 19-20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 19-20 limit the film thickness to a range outside the original claimed thickness of claim 18.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 18-20 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by BASF. BASF (CA 2,221,266) can be found on the applicant's Form PTO-1449.

11. BASF teaches a laminate film having a substrate layer, an interlayer, and a top layer that is back-casted with a component (1) or (1') (p. 30 lines 4-21). A preferred interlayer is a toughened PMMA with special-effect colorants (p. 23 lines 17-26), where the top layer also comprises PMMA (p. 23 lines 4-11). As the component to be back-molded onto the laminate film, the reference teaches ABS, PP, and PC/PBT plastics (p. 30 lines 14-21). The laminate sheets have thicknesses of 100 μ m to 10 mm (0.1-10 mm). Regarding the fiber content of the cast plastic, the reference teaches that component (1), referred to above for back-casting onto a two-layer laminate, comprises 5-50% by weight of a reinforcing fiber (p. 19 lines 10-28). Carbon and glass fibers are noted, having lengths of 1-10 μ m. The reference also notes the possibility of adding mineral fibers. Regarding the mineral filler limitation of claim 18, it is the examiner's position that this limitation bears little patentable weight since the claim only requires the *possibility* of an addition of mineral fillers. It is the examiner's position that the BASF reference teaches this possibility.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 18-20 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over BASF in view of Rohrmann.
14. BASF applies as above but fails to specifically exemplify the use of fibers in the component (1') to be back-molded. Rohrmann teaches polypropylene molding compositions having 0.5-15% by weight of dark mineral fibers (abstract). The moldings are used for motor vehicles, an application noted by BASF. The fibers allow the production of inexpensive thermoplastic materials to be processed by conventional shaping techniques (col. 2 lines 26-31) and also provide reinforcement (col. 4 lines 23-25). Glass fiber reinforcing fillers may also be added for increased reinforcement (col. 4 lines 3-4). They have a length of 0.2-20 mm (col. 4 lines 5-10). It is the examiner's position that it would have been prima facie obvious to use Rohrmann's fiber-reinforced plastic to back-cast onto the laminates of BASF at any thickness necessary to provide inexpensive moldings with improved reinforcement.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb


RABON SERGENT
PRIMARY EXAMINER